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| EXAMINER |
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BUMGARNER, MELBA N

| ART UNIT | PAPER NUMBER |
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3732

| NOTIFICATION DATE | DELIVERY MODE |
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01/10/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LegalUSDocketing@mmm.com
LegalDocketing@mmm.com

Office Action Summary

Application No.

10/771,641

Applicant(s)

RABY ET AL.

Examiner

Melba Bumgarner

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 1707.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>10/17/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 38 and 74 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a bracket, does not reasonably provide enablement for a sheath, a button or an arch wire. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The specification does not describe the planar guide(s) rendered for these appliances and how the planar guide(s) aid the practitioner in placement of such appliances.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-38, 44-50, 64, 66, and 78 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Recitation of "the planar guide" lacks sufficient antecedent basis. It is not clear as to what is a midsagittal plane, a midlateral plane, a midfrontal plane, occlusal-gingival axis of the *orthodontic appliance*.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 10, 12, 13, 18, 19, 31-35, 37, 38, 39-43, 49, 51-55, 73-78, and 80-82 are rejected under 35 U.S.C. 102(b) as being anticipated by Chapoulaud et al. (2002/0028417).

Chapoulaud et al. disclose a method, system and medium comprising rendering a digital representation of a dental arch within a three-dimensional environment, displaying the planar guide within the 3D environment as a visual aid to a practitioner in the placement of an orthodontic appliance relative to the dental arch, wherein displaying the planar guide comprises rendering the guide at a location that is based on a position of the appliance in the 3D environment (figure 5G), [0090]. The planar guide is within the 3D environment relative to a coordinate system. The planar guides are displayed as semi-transparent two-dimensional plane within the three-dimensional environment comprising at least two lines. Chapoulaud et al. show appliance adjusted by the practitioner on a computer so as to change the bracket relative to the tooth. Chapoulaud et al. show storing data that describes attributes for orthodontic appliances [0084] that include parameters such as torque angles. Stored three-dimensional data of the teeth would include dimensions and distances of teeth. Chapoulaud et al. show displaying reference markers of points or tic marks at discrete intervals. A parallel object can be placed in the three-dimensional environment such that it is a constant distance to the displayed contour lines on the guide. Chapoulaud et al. show orthodontic appliance of a bracket. Chapoulaud et al. show controls provided on display of a computer for selecting various views or actuating various

calculations or commands. Chapoulaud et al. show orthogonal x,y,z coordinates. Chapoulaud et al. show the computing device coupled via network to database (figure 1).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-9, 11, 14-17, 20-28, 36, 44-48, 50, 56-64, and 67-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chapoulaud et al. Chapoulaud et al. disclose a method and system that shows the limitations as described above; however, they do not show planar guides representing guides other than what is understood to be midsagittal planar guide of a bracket. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the planar guides represent other visual locations of a bracket relative to a tooth. Chapoulaud et al. disclose a method and system that shows the limitations as described above; however, they do not show planar guides having different colors. Chapoulaud et al. teaches display of the three-dimensional teeth with each tooth in a different color. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method and system to have the planar guides in different colors in order to be able to identify them by color in view of Chapoulaud et al. Chapoulaud et al. show adjusting the color and transparency as noted by adjustments in brightness and shading disclosed. It would have been obvious to one of ordinary skill in the art to store planar guide data of attributes received input from the user. It would have been obvious to one of ordinary skill in the art to size or scale the

guides with respect to the displayed tooth or teeth. It would have been an obvious matter of choice to one of ordinary skill in the art to visually enclose a volume of two planar guides. It would have been obvious to one of ordinary skill in the art as to attributes of the bracket including a shear angle.

9. Claims 29, 30, 65, 66, and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chapoulaud et al. in view of Kopelman et al. (2003014509). Chapoulaud et al. disclose a method and system that shows the limitations as described above; however, they do not show data of rules for orthodontic appliance. Kopelman et al. teach a method and system comprising data 110 of rules for applying the orthodontic appliance. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method and system to comprise data of rules in order to obtain a desired outcome of positioning and orientation in view of Kopelman et al.

Response to Arguments

10. Applicant's arguments filed October 17, 2007 have been fully considered but they are not persuasive. It is noted that the IEA does not make patentability determinations. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). Objects such as orthodontic appliances are not defined in terms of terminology such as midsagittal as the dental arch may be. "Midsagittal" is not used in dentistry to mean dividing a multitude of objects with respect to

dental arch each into left and right halves. Applicant argues by applying the terminology with respect to an orthodontic bracket which is only shown to be rectangular, and does not apply it to other types of orthodontic appliances such as a sheath. It is believed the prior art shows method, system and computer medium as claimed to visually aid a user in placement of an orthodontic bracket in 3D environment, the displayed images include what can be called planar guides.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melba Bumgarner whose telephone number is 571-272-4709. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriquez can be reached at 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Melba Bumgarner/
Primary Examiner